

### **REMARKS/ARGUMENTS**

The Examiner is thanked for the Office Action mailed November 10, 2008. The status of the application is as follows:

- Claims 1-24 are pending, and claims 1, 2, 3, 4, 7, 8, 9, 10, 13, 14, 20 and 21 have been amended;
- Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph;
- Claims 13 and 20 are objected to for informalities;
- Claims 13-19 and 20-24 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter;
- Claims 1, 2, 7-8, 13-14 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art (APA) in view of Lamkin et al. (US 7,178,106 B2);
- Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art in view of Lamkin et al., and further in view of Smyers et al. (US 5, 991,520);
- Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art in view of Lamkin et al. and further in view of Messer et al. (US 6,762,798 B1); and
- Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art in view of Lamkin et al. in view of Messer et al., further in view of Smyers et al.

The objections and rejections are discussed below.

#### **Claim Informalities**

Claims 1, 2, 3, 4, 7, 8, 9, 10, 14 and 21 have been amended to correct informalities.

#### **The Allowed Claims**

The Examiner is thanked for indicating that claims 3-6, 9-12 and 17-19 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant reserves the right to re-write claims 3-6, 9-12 and 17-19 as indicated by the Examiner at a later time.

**The Rejection of Claims 1-24 under 35 U.S.C. 112, Second Paragraph**

Claims 1-24 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Particularly, the Office asserts that independent claims 1, 7, 13 and 20 do not clearly indicate what is meant for "the external interface" since the subject claims recite the external interface within the digital audio playback device.

In an attempt to clarify the foregoing, the undersigned conducted a telephone conference with the Examiner on January 30, 2009. The Examiner indicated that she thought it was unclear whether "the external interface" recited in the claims was external from or within the connected processing system or digital audio playback device. Claims 1 and 7 have been amended to recite that "the external interface" is included within the digital audio playback device. Accordingly, the foregoing rejection of these claims is moot.

With respect to claims 13 and 20, neither of these claims recite "the external interface" as asserted by the Office. Accordingly, the rejection of these claims is moot.

Claims not addressed above are allowable at least by virtue of their dependency upon an allowable base claim.

**The Objection to Claims 13 and 20**

Claims 13 and 20 are objected to for informalities. Particularly, the Office asserts that there is an error in the preamble of the claim with the phrase "For use" (line 1) and this should be changed to a "Method for use". Applicant respectfully disagrees. However, for the sake of fruitful prosecution, claims 13 and 20 have been amended as the Examiner has suggested, rendering the foregoing objection moot.

**The Rejection under 35 U.S.C. 101**

Claims 13-19 and 20-24 stand rejected under 35 U.S.C. 101. In particular, the Office asserts that the claims are directed to non-statutory subject matter. More particularly, the Office asserts that the claims should positively recite the apparatus that accomplishes the recited method steps. In the telephone conference conducted with undersigned on January 30, 2009 the Examiner suggested adding to the subject claims an apparatus such as a processor that performs

the corresponding method step. The subject claims have been amended as suggested by the Examiner, and this rejection should be withdrawn.

**The Rejection of Claims 1, 2, 7-8, 13-14 and 20-21 under 35 U.S.C. 103(a)**

Claims 1, 2, 7-8, 13-14 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art in view of Lamkin et al. This rejection should be withdrawn because the combination of Admitted Prior Art and Lamkin et al. does not establish a *prima facie* case of obviousness with respect to the subject claims.

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed. *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_ (2007). MPEP §2143.

Amended independent **claim 1** is directed to a digital audio playback device including, *inter alia*, a memory included within the digital audio playback device storing a reverse DAPD application programming interface (API); and the reverse DAPD API causing a processor to access and control a user interface associated with a user interface application program and displayed on a monitor screen associated with a connected processing system. The combination of the APA and Lamkin et al. does not teach or suggest these claim aspects.

First, Lamkin et al. teaches an API that is stored on a storage device of a connected processing system (computing device) and not in the memory included within the digital audio playback device (col. 3, lines 9-28). Thus, Lamkin et al. does not teach or suggest a reverse DAPD application programming interface (API) stored on a memory of a digital audio playback device and does not make up for the deficiencies of the APA.

Next, the Office concedes that the APA does not teach the claimed reverse DAPD API capable of causing a processor to access and control a user interface and displayed on a monitor screen associated with the connected processing system. In an attempt to make up for this conceded deficiency, the Office asserts that Lamkin et al. teaches this claim aspect (citing col. 3, lines 20-28, col. 6, lines 56-63, col. 7, lines 63-67, col. 10, lines 3-10 and col. 6, lines 14-20). Applicant respectfully traverses this assertion. There is no teaching or suggestion in the cited

sections of Lamkin et al. that the API is capable of causing a processor of the DAPD to access and control a user interface associated with a user interface application program and displayed on a monitor screen associated with the connected processing system as required by claim 1. Instead, Lamkin et al. teaches an application programming interface residing on a storage device of a computing device that is operably coupled to a removable media and a network for displaying combined content from the removable media and the network on a display. Accordingly, this rejection should be withdrawn.

Independent **claims 7, 13 and 20** are directed to a processing system and related methods with claim aspects similar to those recited in claim 1. As such, the above discussion with respect to claim 1 applies *mutatis mutandis* to claims 7, 13 and 20, and these rejections should be withdrawn.

**Claims 2, 8, 14 and 21** respectively depend from claims 1, 7, 13 and 20, and are allowable at least by virtue of their dependencies.

**The Rejection of Claims 15 and 16 under 35 U.S.C. 103(a)**

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art in view of Lamkin et al. and further in view of Smyers et al. This rejection should be withdrawn because the combination of Admitted Prior Art, Lamkin et al., and Smyers et al. does not establish a *prima facie* case of obviousness with respect to the subject claims.

**Claims 15 and 16** depend from claim 13 and require, *inter alia*, that the reverse DAPD API comprises first data associated with a manufacturer of the digital audio playback device. The Office concedes that the APA and Lamkin et al. do not teach this claim aspect. In an attempt to make up for this conceded deficiency, the Office asserts that Smyers et al. teaches this claim aspect in col. 2, lines 20-30. Applicant respectfully traverses this assertion.

Smyers et al. teaches in the cited section an API that is a collection of programming calls to be used by an application to manage data being written to and obtained from a device over an IEEE 1394 bus. Smyers et al. fails to teach or suggest in the cited section that the API comprises data associated with the manufacturer of the digital audio playback device as required by the subject claims. Accordingly, these rejections should be withdrawn.

**The Rejection of Claim 22 under 35 U.S.C. 103(a)**

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art (APA) in view of Lamkin et al., and further in view of Messer et al. This rejection should be withdrawn because the combination of the APA, Lamkin et al. and Messer et al. does not teach or suggest all the limitations of the subject claim and, therefore, fails to establish a *prima facie* case of obviousness with respect to the subject claim.

**Claim 22** depends from claim 20 and requires, *inter alia*, first data associated with a manufacturer of the digital audio playback device. The Office asserts Messer et al. teaches this claim aspect in col. 11, lines 59-64. However, applicant respectfully traverses this assertion.

Messer et al. does not teach in the cited section the claimed API, which includes data associated with a **manufacturer** of the digital audio playback device. Instead, Messer et al. teaches in the cited section that a set of parameters indicating **a source region** of an image such that a video window is created with the set of parameters when the video window is generated at the destination position and according to the scale factor within the capabilities of the television and display. Hence, the set of parameters are associated with the source region of an image for creating a video window on a display and it is not data associated with the manufacturer of a digital audio playback device. Accordingly, this rejection should be withdrawn.

**The Rejection of Claims 23 and 24 under 35 U.S.C. 103(a)**

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art, Lamkin et al, Messer et al., and further in view of Smyers et al. This rejection should be withdrawn because the combination of the Admitted Prior Art, Lamkin et al., Messer et al, and Smyers et al. does not teach or suggest all the limitations of the subject claims and, therefore, fails to establish a *prima facie* case of obviousness with respect to the subject claims.

**Claim 23** depends from independent claim 20 and requires, *inter alia*, the step of executing the reverse DAPD API comprises the substep of accessing and controlling at least a portion of the user interface displayed on the monitor screen. **Claim 24** depends from claim 20

and requires, *inter alia*, the step of executing the reverse DAPD API comprises the substep of displaying the first data in the at least a portion of the user interface. The Office asserts that the combination of the Admitted Prior Art, Lamkin et al., Messer et al., and Smyers et al. teaches these claim aspects. However, applicant respectfully traverses this assertion.

Particularly, the Office asserts Smyers et al. teaches or suggests the API is capable of causing the processor to access and control at least a portion of the user interface displayed on the monitor screen (see col. 4, lines 1-5 and lines 37-44; col. 5, lines 33-42; col. 7, lines 45-50; col. 9, lines 2-13 and lines 20-27) and the API comprises first data associated with a manufacturer of the digital audio playback device (col. 2, lines 20-30).

However, Smyers et al. does not teach or suggest a user interface on the display accessed and controlled by a processor as is required by claim 23. The API in the video cassette recorder 52 simply manages transfer of data from the video cassette recorder 52 to a bus structure. Upon being presented with the data, the API in the video monitor 54 manages the transfer of the data to buffers in the video monitor 54. Thus, the video monitor 54 is not accessed and controlled by the video cassette recorder 52, but simply receives data from the video cassette recorder 52. Additionally, there is no teaching or suggestion in col. 2, lines 20-30 of Smyers et al. that the API comprises data associated with the manufacturer of the digital audio playback device (video cassette recorder 52). Thus, there is no data displayed in the at least a portion of the user interface as is required by claim 24. Accordingly, these rejections should be withdrawn.

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**Conclusion**

In view of the foregoing, it is submitted that the claims distinguish patentably and non-obviously over the prior art of record. An early indication of allowability is earnestly solicited

Respectfully submitted,

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